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10/783,894

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EXAMINER

CAMPBELL, MATTHEW T

ART UNIT

PAPER NUMBER

2465

NOTIFICATION DATE

DELIVERY MODE

11/10/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/783,894 | <b>Applicant(s)</b><br>KUBLER ET AL. |  |
|                              | <b>Examiner</b><br>MATTHEW CAMPBELL  | <b>Art Unit</b><br>2465              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 44-57,59-63,65-84 and 86-131 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 44-57,59-63,65-84 and 86-131 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                          |

### DETAILED ACTION

1. This office action is in response to the reply filed on 9-12-2011. Claims 44-57, 59-63, 65-84 and 86-131 are presented, of which the independents are 44, 63 and 71.

#### *Response to Arguments*

For the §112 1<sup>st</sup> rejection of claims 44, 63 and 71 and the dependents

The claims are still subject to a 112 1<sup>st</sup> rejection, as per below.

For the §112 1<sup>st</sup> rejection of claims 116, 122 and 128

The rejection is withdrawn in view of the amended claims.

For the §112 1<sup>st</sup> rejection of claims 92, 95 and 98

The claims are still subject to a 112 1<sup>st</sup> rejection, as per below.

For the §112 2<sup>nd</sup> rejection of claim 96

The rejection is withdrawn in view of the claim amendment, which provides proper dependency.

For the §112 2<sup>nd</sup> rejection of claims 44, 63 and 71 and the dependents

The rejection is withdrawn in view of the arguments (**Remarks, p. 23**). The specification describes the host device “directing” control processing circuitry (**p. 274 line 14 - p. 276 line 17**) in response to received dialed digits [information requesting

setup of a call] (**p. 273 lines 13-21**) and cross-reference to a database (**p. 274 lines 1-13**).

For the §102 rejection

Applicant argues that the office action sets for inconsistent interpretation of the teachings of the Isreal reference (**Remarks, p. 24 - p. 27, top**). Examiner disagrees, because Isreal's entire figure 1 constitutes a device for communicatively coupling, of which the NIC14 constitutes a host device and the CP 123 constitutes a part of the device for communicatively coupling. Applicant's broadly claimed "host device" and "device for communicatively coupling" do not impart specific functionality describing the interaction therebetween. If applicant wishes to incorporate further disclosed details of these elements from the specification then it is recommended to amend the claims based thereon.

Applicant further argues that Isreal's notifying does not constitute directions (**Remarks, p. 27, bottom - p. 28, top**). Examiner disagrees, because the NIC's notifying of successful data call completion causes the CP 123 to continue with call setup. If the NIC's data call completion was unsuccessful then it must notify the CP 123 that it was unsuccessful, or, at the very least, not notify the CP 123 that it was successful. Anyway, based thereon, the CP 123 would not continue with call setup. In other words, the NIC's notification to the CP 123 constitutes a direction, because it affects the CP's behavior with call setup. An example of a notification that would not

constitute a direction would be something that would not affect the behavior of the device being notified.

Applicant further argues that the CP selecting a data converter and sending a message to the originating terminal is not a teaching of the CP communicatively coupling, that selection of the data converter is not according to directions from the host device, and the CP is not included in the data transmission path (**Remarks, p. 28**). First, omission of CP 123 from the data transmission path and whether selecting a data converter *per se* constitutes coupling is immaterial, because Isreal clearly teaches the claimed coupling of two networks via the device for coupling as per figure 1, and the coupling is facilitated by the CP. Second, although selection of a specific data converter may not be based on the direction from the host device [notifying of successful data call completion, as discussed above], selection of a data converter at all is based on the direction, since data converter selection would not occur had the directions been different [NIC failing to notify CP of successful completion, or positively notifying CP of unsuccessful completion, as discussed above]. If the invention includes features from the specification in addition to and expending upon those reflected in the claims, then it is recommended that applicant amend the claims to such an effect.

***Claim Rejections - 35 USC § 112 1<sup>st</sup>***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 44-57, 59-63, 65-84 and 86-131 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 44, 63 and 71 recite coupling one of at least two communication networks to either a packet network or another of the at least two communication networks; however, the specification does not teach two communication networks in combination with a packet network. At most the specification teaches coupling one communication network with a packet network (**couple incoming call from telephone switching network 5605 with premises network 5503 over internal routing path, figs 55a, 56a and pgpub ¶¶622-625**). The specification teaches two networks, not three. Thus, the spec does not support the claim in a manner consistent with 112 1st. Dependent claims 45-57, 59-62, 65-70, 72-84 and 86-131 inherit this deficiency.

In response, applicant argues that the computer card 5601 could be installed in wireless access device 5507 acting as its host device, which would result in three networks consisting of the telephone line 5539 [to telephone switching network], wireless network of premises 5501 [packet network], and second transceiver of access device 5507 to wireless phone 5527 (**Remarks: p. 21, whole page - p. 22, top half**). Examiner agrees that telephone line 5539 constitutes a communication network, and that wireless network of premises 5501 constitutes a packet network, but disagrees that

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the second transceiver of wireless access device 5507 coupled to wireless phone 5527 constitutes another communication network. The specification describes that wireless phone 5527 communicates with independent radio channel associated with access device 5507 having second radio transceiver (**pgpub para. 557**), and exchanges voice stream signals in voice stream form without packetization on a communication channel independent of the packet based wireless channel (**pgpub para. 573**). Such is analogous to a conventional analog household cordless phone, which facilitates communication between one handset and one base, and fails to constitute a communication network with an associated information format. The specification does refer to three networks, including a hardwired backbone LAN 5503, the wireless packet network of premises 5501 (**pgpub para. 556**), and the conventional telephone switching network (**pgpub para. 558**). Nowhere is there disclosed a single device that offers coupling to all three.

Claims 92, 95 and 98 recite determining the buffering period of time during the communication of voice, and the voice path is attenuated, if the propagation delay [not variation thereof] of the packet network is above a predetermined threshold level.

First, the determining the buffering period of time is calculated at different stages of a call based loosely on the variation of propagation delay, not a threshold delay (**see claims 116, 122 and 128; and p. 284 line 13 - p. 285 line 7**). Second, the specification never refers to “attenuation”, but applicant seems to be referring to the transition from full-duplex to half-duplex, which is not performed in reaction to a threshold level but only

when "required queuing and delivery time delays prove too long, e.g., to a point where they might annoy a calling party" (**p. 283 line 17 - p. 284 line 2**). Third, the specification refers to "a predetermined threshold value" only in relation to the maximum point at which voice communication should be possible with relatively unnoticeable delays (**p. 283 line 3 - p. 283 line 16**). There is no nexus between exceeding a threshold of noticeable delay and queuing times proving to be so long and annoying that they invoke the full-duplex to half-duplex transition. It is strongly recommended that applicant adhere to the terms of the disclosure in drafting the claims in order to facilitate determining the scope of the invention and to prevent speculation thereof.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 44, 63 and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Isreal et al. (US 4723238 A).

For claim 44, Isreal teaches a method of operating a device for communicatively coupling one of at least two communication networks, each having an associated information format (**CSS 12 and port circuit 122-K to other CSS 'two communication networks', fig. 1 and col. 2 lines 40-46. Multiple PSS 13 systems, col. 13 lines 1-**



**13)**, to either a packet network (**PSS 13 ‘packet network’, fig. 1 and col. 2 lines 52-63**) or another of the at least two communication networks, the method comprising:

receiving, from the packet network or the one of at least two communication networks, information requesting setup of a call between the one of at least two communication networks and either the packet network or another of the at least two communication networks (**network interface card 14 receives call originating from packet terminal 131-X or circuit terminal 121-X or other circuit network 122-K, fig. 1 and col. 3; CSS-PSS call, col. 3 lines 22-44 and col. 9 line 15; CSS-CSS call, col. 3 lines 45-54; and PSS-CSS call, col. 3 line 55 - col. 4 line 11 and col. 11 line 20**);

providing, to a host device, at least a portion of the information requesting setup of a call (**Terminal 121-1 dials a data call request to call processor (CP) 123. The CP 123 checks a terminal location table (201 of FIG. 2) to determine if the destination terminal 131-M is located in CSS 12 or PSS 13. Since destination terminal 131-M is located on PSS, CP 123 forwards the call request to NIC 14 ‘host device’, col. 3 lines 24-30**);

receiving, from the host device, directions based upon the at least a portion of the information requesting setup of a call (**The NIC 14 acts like a terminal on PSS 13 and attempts to complete the data call to destination terminal 131-M. If the data call set-up on PSS 13 is successful, NIC 14 notifies CP 123 accordingly ‘directions’, col. 3 lines 30-33**); and

communicatively coupling the one of at least two communication networks to either the packet network or another of the at least two communication networks,

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according to the directions from the host device (**The CP 123 then selects a data converter (e.g., 145D) for the call and sends an appropriate message back to the originating terminal 121-1. The data transmission path for the established data call includes originating terminal 121-1, port circuit 122-1, TDM bus 124, T/R 147, data bus 154, NPE 152, data converter 145D, NAU bus 146, CSMA interface controller 141, NAU 132-1 and destination terminal 131-M, col. 3 lines 33-41).**

Claim 63 is rejected for the same reason as claim 44, except that it is directed to a machine readable medium.

Claim 71 is rejected for the same reason as claim 44, except that it is directed to an apparatus.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW CAMPBELL whose telephone number is (571)270-3988. The examiner can normally be reached on Monday through Friday from 9:00am until 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 2465

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